

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Tomoyuki YAMAMOTO	)	Group Art Unit: 2421
	)	
Application No.: 10/768,841	)	
	)	Examiner: Schnurr, John R.
Filed: January 30, 2004	)	
	)	
For: SYSTEM AND METHOD FOR	)	Confirmation No.: 7117
SEARCHING AND PROVIDING	)	
CONTENTS, AND SOFTWARE	)	
STORAGE MEDIA	)	

**Mailstop: AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicant respectfully requests a pre-appeal brief review of the rejections in the Final Office Action dated October 25, 2010. A Notice of Appeal and relevant fee payments accompany this request.

**I. Requirements for Submitting a Pre-Appeal Brief Request for Review**

Applicant has met each of the requirements for this submission and therefore request review of the Examiner's rejections in the Final Office Action for the following reasons. This application has been rejected at least twice. Applicant has concurrently filed a Notice of Appeal. Applicant submits this Pre-Appeal Brief Request for Review setting forth legal or factual deficiencies in the rejections in five (5) pages or less. *See* Official Gazette Notice, July 12, 2005.

## II. The 35 U.S.C. § 103(a) Rejections are Legally Deficient

The rejections of claims 43-45, 47-53, 55-59, 62-66, 69-76, and 78-81, and 84-88 are legally deficient because the Examiner has not properly resolved the *Graham* factual inquiries, the proper resolution of which is the requirement for establishing a framework for an objective obviousness analysis. See M.P.E.P. § 2141(II), citing to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), as reiterated by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In particular, the Examiner has neither properly determined the scope and contents of the prior art, nor properly ascertained the differences between the claimed invention and the prior art, at least because the Examiner has not interpreted the prior art and considered both the invention and the prior art as a whole. See M.P.E.P. § 2141(II)(B).

The Examiner alleged that *Maissel*'s "NEXT" key discloses the claimed "jump from the first position within the first content item immediately subsequent to the current replay position to the second position without accessing the intervening contents between the first position and the second position," as recited in claim 43. See Final Office Action, pages 3-4. This is incorrect. The Examiner mischaracterized *Maissel*.

According to *Maissel*, the "NEXT" key is used to "access[ ] a start point of a program which follows the program in the memory 55." *Maissel*, paragraph [0368]. That is, when a user presses the "NEXT" key on *Maissel*'s remote controller, a next program, rather than a next position within the current program, will be displayed. Although *Maissel* discloses that there may be a plurality of "NEXT" buttons, "wherein each of the plurality of "NEXT" buttons may be used in association with a hierarchy" (*Maissel*, paragraph [0369]), *Maissel* clearly discloses that such hierarchy is characterized by, for example, stories, sections, or type of programs (news, sports, etc.), each of which is a complete piece of content. See *Maissel*, paragraphs [0369-0371]. That is, by pressing one of the "NEXT" buttons, a user may pass "from a first story in a news program to [a start point] of a second story in the news program" (*Maissel*, paragraph [0370]) or "from a news section related to politics in the program to [a start point of] a news section related to sports in the program" (*Maissel*, paragraph [0371]), but cannot "jump from [a] first position within the first content item [e.g., a story or a news section] ... to [a] second position [also within the same content item] without accessing the intervening contents between the first position and the second position," as recited in claim 43 (emphases added).

Therefore, although *Maissel* discloses a hierarchy of programs, one of ordinary skills in the art would have understood that *Maissel*'s "NEXT" button is used to access the start point of each piece of content in the hierarchy. For discussion purpose only, such operation is similar to the "second function" performed by the input means of claim 16, but cannot constitute the claimed "first function."

Moreover, one of ordinary skills in the art would not have been motivated to modify *Maissel* in view of *Eyer* by combining the plurality of "NEXT" buttons into a single button because that would defeat the intention of *Maissel* of associating the buttons with a hierarchy. One of ordinary skills in the art would not consider a single button as an efficient means of displaying a hierarchy structure.

### III. Conclusion

Therefore, the rejection of claims 43-45, 47-53, 55-59, 62-66, 69-76, and 78-81, and 84-88 does not meet the requirements of M.P.E.P. § 2141 and 35 U.S.C. § 103(a), and thus, is legally deficient and should be withdrawn. Claims 43-45, 47-53, 55-59, 62-66, 69-76, and 78-81, and 84-88 should be allowed.

Respectfully submitted,

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Dated: February 25, 2011

By: \_\_\_\_\_

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